

Application Serial No. 09/683,273
Reply to Office Action of December 3, 2004

PATENT
Docket No. CU-3641

REMARKS/ARGUMENTS

Reconsideration is respectfully requested.

Claims 1-2 are pending in the present application before this amendment.

Claims 1-2 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,733,628 (Middleton) in view of U.S. Patent Nos. 6,383,129 (Ardizzone) and 6,448,306 (Lever). The "et al." suffix, which may appear after a reference name, is omitted in this paper.

By the present amendment, Claim 1-2 have been amended; and Claim 3 has been added. No new matter has been added.

As to Claim 1:

Applicant respectfully re-points out the acknowledgment in the Office Action that Middleton does not teach an outer spandex layer and the neoprene layer being anti-bacterial and being included with bio-ceramics. However, Applicant respectfully disagrees with the Office Action (1) that the combination of the three cited references teach all limitations of Claim 1 and (2) that the motivation or suggestion to combine the references are found in the references themselves.

As it is well founded in the patent case law and consistently in MPEP, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. MPEP §2142. There are three requirements to establish the *prima facie* obviousness. MPEP §2143.

(1) First, the prior art references must teach or suggest all the claim limitations. MPEP §2143.03.

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(2) Second, there must be some suggestion or motivation, either in the reference or itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP §2143.01.

(3) Third, there must be a reasonable expectation of success. MPEP §2143.02.

As to the point (1) above, it is respectfully submitted that the claimed limitation --a single medium layer made from anti-bacterial neoprene and bio-ceramics-- of Claim 1, now amended, is not taught or suggested in any of the cited three references, whether they are considered individually or taken together.

Middleton describes only a "neoprene rubber" layer as in element 1 of all FIGS. 1-3b. Both Middleton and Lever fail to even disclose or suggest the bio-ceramics material. Ardizzone discloses a separate layer of bio-ceramic fibers 80 (FIG. 4). However, the medium layer of Claim 1 is not a separate layer of bio-ceramic fibers as in Ardizzone. The claimed medium layer is a single layer made from both neoprene and bio-ceramics. That is to say that the claimed medium layer is not, for example, a laminate of two or more layers, one of which being a bio-ceramics fiber layer, as shown in Ardizzone. As shown in FIG. 1 of the present application, the medium layer 30 is a single layer made from both the neoprene and bio-ceramics. At least on this ground, Applicant respectfully submits that neither Middleton, Ardizzone, nor Lever, whether they are taken together or individually, teaches the claimed --single medium layer made from anti-bacterial neoprene and bio-ceramics--.

As to point (2) above, Applicant respectfully disagrees with the assertion

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in the Office Action that the proper motivation to combine the bio-ceramics fiber of Ardizzone with the teachings of Middleton and Lever is found.

According to MPEP §2143.01, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teaching.

The suggestion or motivation to combine references must come from the cited prior art references, either explicitly or implicitly. The mere fact that the teachings of the prior art can be modified or combined does not establish a motivation or suggestion to combine and make the resultant combination *prima facie* obvious. The prior art itself must suggest the desirability of the combination. MPEP §2143.01.

The Office Action indicates the bio-ceramics fiber disclosed in Ardizzone is a "fiber" material, and, as understood by Applicant, the Examiner takes an official notice that the fibers are "well known and understood in the construction of fabrics."

However, it is respectfully submitted that the combination of Ardizzone with other references (and the taking of such official notice) is improper because Ardizzone is not analogous to the claimed invention.

According to MPEP §2141.01(a), any prior art reference, in order to be modified or combined with another prior art reference, must be "analogous" to the claimed invention. In order for a prior art reference to be "analogous" to the Applicants' claimed invention, the prior art reference must (1) be "in the field of

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Applicants' endeavor;" or (2) if, not, then it must be reasonably pertinent to the problem addressed. *In re Wood*, 699 F.2d 1032 (CCPA 1979).

Ardizzone only discloses the use of bio-ceramics fibers encased in what appears to be some kind of magnetic medallion that is used for magnetotherapy.

Ardizzone cannot be considered to be in the same field of Applicants' endeavor, because Ardizzone apparently is not in the field of endeavor of the presently claimed invention relating to clothing and/or fabrics. "Magnetotherapy" and the plastic or hard encased device for the magnetotherapy should be considered as being very distinct and separate from the technology of the present invention.

The conclusive statement of obviousness in the Office Action that, because the word "fiber" is used in Ardizzone (which relates to a non-analogous art), that fiber of Ardizzone can be applied in the field of clothing or fabrics is based on an impermissible presumption. Applicant's response to such a conclusive statement of obviousness is that the basis for improperly finding the presently claimed invention obvious appears to be the teaching found in this application, and not in the prior art. Thus, the obviousness rejection in the Office Action Improperly relies on the impermissible hindsight reasoning, because the rejection would not be obvious absent Applicants' disclosure in this application that discloses the claimed -- single medium layer made from anti-bacterial neoprene and bio-ceramics. (See 37 C.F.R. § 1.104(c)(2).)

For the reasons above, it is respectfully submitted that Ardizzone should not be considered as being analogous to the presently claimed invention. Accordingly, an indication that Claim 1 is in condition for allowance is

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respectfully requested.

As to Claims 2-3:

Applicant respectfully reasserts the remarks above with respect to Claim 1 and submits again (1) that the cited references (individually or in combination) do not teach or suggest the claimed medium layer made from neoprene and bio-ceramics (2) that Ardizzone lacks valid motivation or suggestion for combination with any other references.

Furthermore, Claims 2-3 recite micro pores in the medium layer where -- the outer layer and the inner layer substantially cover the openings of the medium layer micro pores--. The support for this limitation is found at least in FIG. 2 of the present application where the outer layer 10 and the inner layer 20 substantially covers the opening of the micro pores 40.

In contradistinction, the chamber 7 as shown in all figures of Ardizzone are open at one or both openings. As in FIG. 1 of Ardizzone, the second layer 2 is open for example at the narrow region 6. FIG. 3a of Ardizzone shows that both layers 2 and 9 are open at the ends of the chamber 7. FIG. 3b of Ardizzone even teaches that the one layer 9 can even be broken to create an opening at one end of the chamber 7. This is substantially different from the presently claimed inventions of Claims 2-3 where the micro pore openings are substantially covered. Accordingly, withdrawal of the rejections and allowance of Claims 2-3 are respectfully requested.

As to Claim 3, the support for --an outer layer made from at least poly-urethane-- is found in the Specification paragraph [0014]. Furthermore, the

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preamble of Claim 3 has been amended to --consisting of--, and the claimed fabric --consisting of-- the recited limitations of Claim 3 is not taught or suggested in any of the cited references.

For the reasons set forth above, Applicant respectfully submits that:

Claims 1-3, now pending in this application, are in condition for allowance over the cited references. This amendment is considered to be responsive to all points raised in the Office Action. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and earnestly solicits an indication of allowable subject matter. Should the Examiner have any remaining questions or concerns, the Examiner is encouraged to contact the undersigned attorney by telephone to expeditiously resolve such concerns.

Respectfully submitted,



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Dated: April 30, 2004